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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,634	08/24/2001	Jeffrey Green	NAI1P092/01.050.01	1385
28875	7590	11/15/2004	EXAMINER	
Zilka-Kotab, PC			LIN, KELVIN Y	
P.O. BOX 721120			ART UNIT	PAPER NUMBER
SAN JOSE, CA 95172-1120			2142	

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,634

Applicant(s)

GREEN ET AL.

Examiner

Kelvin Lin

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/31/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-36 are rejected under 35 USC 102(e) as being anticipated by Maloney et al., (U.S. Patent 6549208).
3. Regarding claim 1, Maloney teaches a method carried out by a computer when executing computer-readable program code, the method comprising:
 - receiving a certain electronic file intended for delivery from a sender to an intended recipient, the certain electronic file having a first file format and containing a computer virus (Maloney, col.2, l.45-54); and
 - prior to the certain electronic file being made available for viewing by the intended recipient, converting the certain electronic file to a second file format that is different from the first file format and that prevents the computer virus from executing when the converted

electronic file is opened by the intended recipient (Maloney, col. 4, I.39-42)

4. Regarding claim 2, Maloney further discloses the method of claim 1, the certain electronic file being an attachment to an electronic mail sent over a network (Maloney , col. 2, I.54).
5. Regarding claim 3, Maloney further discloses the method of claim 2, the network including the internet (Maloney, col.6, I.30-31).
6. Regarding claim 4, Maloney further discloses the method of claim 1, said receiving occurring at a desktop computer of the intended recipient (Maloney, col.5, I.59-61).
7. Regarding claim 5, Maloney further discloses the method of claim 1, said receiving occurring at a server computer (Maloney, Fig.6, col. 4, I.36).
8. Regarding claim 6, Maloney further discloses the method of claim 1, said receiving occurring at a gateway computer (Maloney, Fig. 6, col.11, I.55) .
9. Regarding claim 7, Maloney further discloses the method of claim 1, said converting occurring at a desktop computer of the intended recipient (Maloney, Fig. 3, col. 2, I.24-25, col. 5, I.60, col.7, I. 30-33, " .. that means the collection of multiple interconnected computer of intended recipient including the PC.. ").
10. Regarding claim 8, Maloney further discloses the method of claim 1, said converting occurring at a server computer (Maloney, Fig. 3, col. 2, I.24-25, col. 4, I.36, col.7, I. 30-33, " .. that means the collection of multiple interconnected

computer of intended recipient including the server computer.. “).

11. Regarding claim 9, Maloney further discloses the method of claim 1, said converting occurring at a gateway computer (Maloney, Fig. 3, Fig. 6, col. 2, l. 24-25, col. 11, l. 55, col. 7, l. 30-33, “ .. that means the collection of multiple interconnected computer of intended recipient including the server computer.. “).
12. Regarding claim 10, Maloney further discloses the method of claim 1, said converting occurring prior to the intended recipient receiving the certain electronic file (Maloney, col. 2, l. 50-51).
13. Regarding claim 11, Maloney further discloses the method of claim 1, further comprising:
 - determining whether the certain electronic file represents a potential risk to security of a computer system (Maloney, col. 2, l. 30-33, l. 50-51),
 - said converting the certain electronic file being in response to a determination that the certain electronic file represents the potential risk to the security of the computer systems (Maloney, col. 2, l. 2-3, col. 6, l. 33, l. 66-67, col. 7, l. 1-4).
14. Regarding claim 12, Maloney further discloses the method of claim 11, said determining whether the certain electronic file represents the potential risk comprising: determining if the certain electronic file contains the computer virus (Maloney, col. 12, l. 35-38).
15. Regarding claim 13, Maloney further discloses the method of claim 11, said

determining whether the certain electronic file represents the potential risk comprising: conducting a heuristic scan of the certain electronic file (Maloney, col. 9, l.39-44).

16. Regarding claim 14, Maloney further discloses the method of claim, the certain electronic file being a first electronic file, further comprising:

- receiving a second electronic file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus (Maloney, col.4, l.49); and
- prior to the second electronic file being made available for viewing by the another intended recipient, converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient (Maloney, col.11, l.36-41, col.12, l.16-24, “ which means the analysis system established a target source packet format which could be modified to shut down a target under attack).

17. Regarding claim 16, Maloney further discloses the method of claim 1, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, a BMP file format, a JPEG file format, a CSV file format, a JPB file format, a GIF file format, a HTML file format without scripts, and a ASCII

file format (Maloney, col. 10, l.24-25) .

18. Regarding claim 17, Maloney further discloses the method of claim 16, the second file format being the HTML file format without scripts (Maloney, col. 10, l.24-25).
19. Regarding claim 18, Maloney further discloses the method of claim 16, the second file format being the ASCII file format file (Maloney, col.1, l.10-11).
20. Regarding claim 19, Maloney further discloses the method of claim 16, the second file format being the TXT file format (Maloney, col. 6, l.52-53).
21. Regarding claim 20, Maloney further discloses the method of claim 1, the second file format being a file format having text without scripts (Maloney , col. 10, l.1-4).
22. Regarding claim 21, Maloney further discloses the method of claim 1, the certain electronic file being at least one of a word processing file, a spreadsheet file, a database file, a graphics file, a presentation file, a compressed file, and a binary executable file (Maloney, col. 6, l.55-56, col.10, l.30-32).
23. Regarding claim 22, Maloney further discloses the method of claim 1, further comprising:
 - determining if the first file format is one of a word processing file format type and a graphics file format type (Maloney, col.10, l.30-32),
 - the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format

without scripts if it is determined that the certain file format is the word processing file format type (Maloney, col. 6, l.52-53),

- the second file format being at least one of a JPB file format, a BMP file format, a GT file format, a HTML file format without scripts, and a TPEG file format if it is determined that the first file format is the graphics file format type (Maloney, col. 10, l.30-33).

24. Regarding claim 23, Maloney further discloses the method of claim 1, the certain electronic file being an electronic file received by at least one of a RTP transfer or a HTTP transfer protocol (Maloney, col. 5, l.2).

25. Regarding claim 24, Maloney further discloses a method for implementing a security policy, the method comprising:

- determining whether an electronic file represents a potential risk to security of a computer system (Maloney, col. 2, l.15-19); and
- prior to making the electronic file available to an intended recipient of the electronic file, converting the electronic file into a safe format that ensures that a computer virus in the electronic file is unable to harm the computer system (Maloney, col. 1, l.60-67).

26. Regarding claim 25, Maloney further discloses the method of 24, said determining comprising:

- Determining whether the electronic file has a file extension indicative of a file type that supports a potential computer virus (Maloney, col.4, l.42-61).

27. Regarding claim 26, Maloney further discloses the method of 24, said determining comprising: detecting whether the electronic file contains the computer virus (Maloney, col.1, l.56-58, col.2, l.17,).
28. Regarding claim 27, Maloney further discloses the method of 24, said determining comprising: determining whether content of the electronic file reflects a potential computer virus (Maloney, col. 2, l. 48-51).
29. Regarding claims 28-35 have similar limitation as claims 1,2, 10-12, 15-16, and 22. Therefore, claims 28-35 are rejected under Maloney for the same reason set forth in the rejection of claim 1,2,10-12, 15-16.
30. Regarding claim 36, Maloney further discloses an apparatus comprising:
 - a computer having means for receiving a certain electronic file intended for delivery from a sender to a intended recipient, the certain electronic tile having a first file format and containing a computer virus (Maloney, col.2, l.45-54);
 - the computer further including means for converting, prior to the certain electronic file being made available for viewing by the intended recipient, the certain electronic file from the first file format to a second file format that is different from the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient (Maloney, col. 4, l.39-42).

31. Regarding claim 37, Maloney further discloses the apparatus of claim 36, said computer being a desktop computer of the intended recipient (Maloney, col.5, l.59-61).
32. Regarding claim 38, Maloney further discloses the apparatus of claim 36, said computer being a server computer of a local area network (Maloney, Fig.6, col.2, l.26-27).
33. Regarding claim 39, Maloney further discloses the apparatus of claim 36, said Computer being a gateway computer (Maloney, Fig. 6, col.11, l.43-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claims 15, and 34 are rejected under 35 U.S.C 103(a) as being unpatentable over Maloney in view of Chen (US Patent 5960170).
35. Regarding claims 15, and 34 Maloney differs from the claimed invention in that it does not explicitly indicate the computer virus including macro virus, instead of stating " ...to determine if a computer virus is present.. and then determining if the generic structure is resident in ... e-mail attachments.. "

(Maloney, col. 2, l.50-54). Chen teaches “the **macros viruses** used in the electronic mail ...” (Chen, col.14, l.54-57). With Chen’s elaboration and Maloney’s description, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Chen’s definition of macro virus with Maloney’s e-mail attachment assertion and identified them more clearly.

Conclusion

The prior art made of record and not relied upon is considered pertinent to application's disclosure.

- Chen et al., (Patent No. 5832208) Anti-Virus Agent for Use With Database And Mail Servers.
- Cooper et al., (PG Pub. No. 2002/0029350) Web Based Human Services Conferencing Network.
- Ji et al., (Patent No. 5889943) Apparatus And Method For Electronic Mail Virus Detection And Elimination.
- IEEE – Omura Jim K., "Novel Applications of Cryptography in Digital Comms", Communication Magazine, IEEE, Vol. 28, Issue:5, May, 1990, pp.21-29.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 571-272-3898.


The examiner can normally be reached on Flexible 4/9/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 571-272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/10/04
KYL



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SUPERVISORY PATENT EXAMINER